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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/807,432  | 03/24/2004  | Tadashi Yoshida      | 1341.1197           | 4260             |
| 21171   | 7590        | 03/09/2007           | EXAMINER            |                  |
| STAAS & HALSEY LLP<br>SUITE 700<br>1201 NEW YORK AVENUE, N.W.<br>WASHINGTON, DC 20005 |             |                      | HUYNH, NAM TRUNG    |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2617                |                  |
| SHORTENED STATUTORY PERIOD OF RESPONSE  | MAIL DATE   | DELIVERY MODE        |                     |                  |
| 3 MONTHS  | 03/09/2007  | PAPER                |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/807,432             | YOSHIDA ET AL.      |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Nam Huynh              | 2617                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 December 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3,5,7,9,11,13,15 and 17-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,3,5,7,9,11,13,15, and 17-20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/15/2006 has been entered.

### ***Response to Amendment***

This office action is in response to amendment filed on 12/15/2006. Of the pending claims 1, 3, 5, 7, 9, 11, 13, and 17-20, none of the claims were amended.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 because the claims recite a "computer program for supporting an electronic payment, making a computer execute;" however the body of the claim is limited to the program and fails to mention any type of "computer readable medium", thus effectively claiming a program per se and failing to provide any structural and functional interrelationships between the program and other claimed elements of the computer, which would permit the functionality of the program to be realized and thus are non-statutory. The examiner suggests alternatively amending the claim to recite "A computer readable medium encoded with a computer

program for supporting an electronic payment, making a computer execute;" and thereby claim a statutory computer element containing the program.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1,3, 7, 9, 11, 15, 17, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (US 2002/0065774) in view of Ranganath et al. (US 2001/0037245).

A. Regarding claims 1, 9, 17, and 20, Young et al. discloses a system and method for performing electronic transactions using a browser enabled wireless telephone (abstract). In the scope of the invention, an individual with an electronics communication device such as a mobile telephone (customer mobile telephone) access an electronic transaction portal (electronic-payment support apparatus) via a wireless gateway that allows the gateway to communicate via a computer network such as the

Internet (first Internet). The electronic transaction portal provides access to the home page of a portal (portal site) that includes a listing of accessible, or participating, merchant sites (plurality of store sites) (pages 3, 4, paragraphs 33-35). The mobile telephone user may choose between a variety of means for payment (page 2, paragraph 16) including an electronic wallet application, a payment product assigned by the operator of the portal, or may input data related to another means of payment in order to purchase selected items from the portal. Once the transaction portal server receives this information, the merchant may retrieve the received information, which may indicate the purchase price and method of payment (i.e. credit card). The merchant may use this information to process the transaction from the merchant's acquiring bank or the transaction may be processed using an electronic wallet server (electronic payment unit/external payment system) that is in communication via the Internet (second communication controller) with the transaction portal server (page 4, paragraphs 37, 39, 40).

Young et al. does not explicitly disclose a salesperson terminal that determines and registers at a website an amount and a first communication controller for controlling communication with the salesperson terminal and the customer mobile terminal through a first Internet. Ranganath et al. discloses an e-commerce system and method and apparatus for order processing and inventory management (title). In the scope of the invention, a retailer or employee utilizes a point of sale device (salesperson terminal) to change inventory and the price of items (determine/register and amount informed from a salesperson terminal) offered for sale from an online store (pages 1,2, paragraphs 12,

14). Furthermore, Ranganath et al. teaches communication of a remote device (i.e. the consumer internet appliance or point of sale device) through the Internet (second Internet) with a server via a communication interface (figure 1, item 115) and a processor (figure 1, item 112) (first communication controller). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Young et al. to allow a retailer or merchant to utilize a point of sale device to change inventory and the price of items offered for sale from an online store, as taught by Ranganath et al., in order to allow a retailer or merchant to publish price changes or inventory changes in a prompt manner which would prevent potential loss of revenues or customer dissatisfaction. In the combination of the two references, both the mobile telephone (Young et al.) and the point of sale device (Ranganath et al.) is able to access the electronic transaction portal (Young et al.).

B. Regarding claims 3, 11, and 18, the limitations are rejected as applied to claim 1. In the combination of the two references, the portal of Young et al. would send the order information to software residing on the merchant's web site and the merchant may retrieve the information using the point of sale device of Ranganath et al. that renders the "notification unit" (page 6, paragraph 61).

C. Regarding claims 7 and 15, the limitations are rejected as applied to claim 1. Furthermore, Ranganath et al. discloses that the point of sale device may include a bar code scanner coupled to the micro-controller/processor (page 4, paragraph 51).

6. Claims 5, 13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (US 2002/0065774) in view of Ranganath et al. (US 2001/0037245), and further in view of Byrne et al. (US 2003/0229590).

Regarding claims 5, 13, and 19, the limitations are rejected as applied to claim 3. However, the combination of Young et al. and Ranganath et al. does not explicitly disclose that the customer may pay based upon a pre-registered schedule. Byrne et al. discloses a system and method for Internet payment enablement and support (abstract). In the scope of the invention, a global integrated payment system provides a portfolio of payment solutions to merchants including the capability to collect recurring payments (page 2, paragraph 15). Therefore it would have been obvious to one of ordinary skill in the art to modify the merchant websites of the combination of Young et al. and Ranganath et al. to include the capability of receiving a recurring payments from a customer or buyer, as taught by Byrne et al., in order to offer a more flexible payment solution and in turn provide the potential of increasing sales.

#### ***Response to Arguments***

In the arguments filed on 12/15/2006, Applicant asserts that in Ranganath et al., there is not a communication controller that controls communication with a salesperson terminal and a customer mobile terminal. The Examiner respectfully asserts that the claimed "communication controller" is rendered by a controller/processor of a communications device. Although Young et al. does not explicitly disclose that the transaction portal server includes a processor; it is notoriously well known in the art that communication devices comprise a communication interface (i.e. an antenna or

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modem) that is controlled by a processor or controller to communicate with other communication devices. Furthermore this teaching is disclosed by Ranganath et al. in figure 1, in for instance the application server, where it can be seen that the processor (item 112) controls the communication interface (item 115) and is therefore a "communication controller".

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ferrier (US 2005/0177437)

Villaret et al. (US 2002/0026367)

Kitajima (US 2003/0163416)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nam Huynh whose telephone number is 571-272-5970.

The examiner can normally be reached on 8 a.m.-5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NTH  
3/2/07

  
GEORGE ENG  
SUPERVISORY PATENT EXAMINER